

REMARKS

The Office Action mailed July 22, 2004 has been reviewed and carefully considered. Claims 16-23 have been added. Claim 12 has been canceled without prejudice. Claims 1-11 and 13-23 are now pending in the application. Of these, claims 1, 4, 8 and 18 are the independent claims. Claims 4, 6-9, 14 and 15 have been amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

Claims 4-7 and 14 stand rejected under 35 U.S.C. 112, second paragraph as indefinite, and have been revised in a manner that is believed to overcome any basis for rejection of these claims on the instant basis.

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as unpatentable over the alleged admissions of the applicant (AAA) in view of U.S. Patent No. 5,557,317 to Nishio et al. ("Nishio").

As items 9, 10 and 13 of the Office Action acknowledge, AAA fails to disclose or suggest various limitations of claim 1. The AAA appears to consist of FIGs. 1 and 2 of the present application.

FIG. 1 of the instant specification ("PA FIG. 1") relates to a ring configuration of nodes, one of the nodes being directly connected to a network management system (NMS). Likewise, FIG. 2 of the AAA relates to a linear formation. The NMS according to the prior art transmits, starting at the NMS, update data individually to each (page 3, line 9: "each") node by means of its access to the ring, or

linear formation, through the one node. The NMS controls the updating of each node and distributes the same update data throughout the system to all of the nodes.

Nishio, by contrast, is directed to a video data relocation system which includes a number of nodes and a video management center (VMC) that controls data relocation from one node to another individual node, upon request of the individual node. Nishio, unlike the AAA, does not relate to proliferating common data throughout a network system.

Moreover, in contrast to the AAA in which the new program originates from the NMS, no video data or update data flows from the Nishio VMC. Instead, such data flows strictly from node to node (col. 2, line 65 – col. 3, line 3). Also, as mentioned above, although the AAA proliferates a new program throughout the network to each node, Nishio, by contrast, does not proliferate a particular video program or update data throughout the nodes.

Claim 1 of the present invention recites “allocating a fixed region in a memory . . . , storing the received new program data in the allocated fixed region . . . ; . . . causing the . . . (NMS) to transmit . . . a data-transmitting signal for transmitting the stored new program data . . .”

The AAA, by contrast, neither discloses nor suggests the “data-transmitting signal for transmitting the stored new program data” of claim 1 of the present invention. Yet, the AAA relates to proliferating common data throughout the network. The fact that a requesting, individual Nishio node receives stored data does not fairly suggest the invention as recited in claim 1.

In particular, Nishio fails to suggest a modification of the prior art network disclosed in the AAA that features a “data-transmitting signal for transmitting the stored new program data” in a network that has been “allocating a fixed region in a memory . . . , storing the received new program data in the allocated fixed region” language that explicitly appears in the present claim 1. The signaling protocol set forth in claim 1 of the present invention would not have been obvious over the AAA in view of Nishio.

In determining the differences between the prior art and the claims, the question under **35 U.S.C. 103** is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) MPEP 2141.02.

To reach a proper determination under **35 U.S.C. 103**, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. MPEP 2142. [underlining added for emphasis]

In view of the above-specified fundamental differences between Nishio and the applicant's allegedly admitted prior art (AAA), the fact that Nishio determines a closest node on the bus configuration having the particular program for relocating the program to an individual, requesting node on the bus configuration would not have suggested to one of ordinary skill the art modifying the AAA, i.e., the prior art approach,

to the specific signaling protocol of claim 1, except through impermissible hindsight gained from reading the present disclosure.

In addition and as item 7 of the Office Action acknowledges, the AAA fails to disclose or suggest “allocating a fixed region in a memory within said first predetermined node in response to the reception of the new program data” as explicitly required by the language of claim 1. Item 9 also implicitly acknowledges that Nishio fails to make up the difference, but suggests it would have been obvious “to include memory in each node for storing received data” to “improve” system integrity.

This explanation offered by the Office Action fails to explain, however, why the region in memory is allocated and “fixed” and why the “data-transmitting signal” is “for transmitting the stored new program data.” Since the AAA discloses proliferation throughout the system, it is unclear by what reasoning it could fairly be concluded that the region is “fixed” as opposed to a protocol by which the new program incoming to a node is buffered and forwarded to the next node from the input buffer. It is, in addition, unclear how the Office Action concludes that the one signal in the AAA, i.e., control signal (page 3, lines 10-11: “a control signal”), is obviously expanded to two signals rather than to three or limited to an enhanced, single signal. It is also unclear how the Office Action concludes that the allocating occurs “in response to” the reception of the new program data.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

In addition, the applicant traverses the suggestion in item 15 of the Office Action that lines 51-57 of column 1 in Nishio teach using a data-transmitting signal in conjunction with the program-changing control signal of the AAA.

The program-changing control signal of the AAA is transmitted to the second node, i.e., the node to receive the new program data.

Nishio fails to suggest modifying the AAA so that the first node, i.e., the node to transmit the new program data: (1) receives a data-transmitting signal; and (2) transmits the new program data to the second node.

Firstly, unlike in the AAA, where the first node transmits to the second node, it is a network in Nishio that transmits from the first node to the second node (col. 6, line 63: “circuit switched network”). Moreover, among the “transfer command signals” (col. 6, line 64: “appropriate transfer command signals”) required to make the node-to-node transfer, is at least one transfer command signal to establish a circuit connection between the two nodes. In addition, Nishio lacks disclosure of the control signal to the second node. The Office Action attempts to mix and match control signals to re-create the present invention.

The notion of modifying the relatively simple embodiment of FIGs. 1 and 2 of the present application, i.e., the prior art technique, based upon the intricate protocol in Nishio, which is not even directed to network proliferation of an update, to arrive at a protocol that matches the features presently claimed would have been counterintuitive. It cannot fairly be said that Nishio would have suggested modification of the AAA in the manner proposed by the Office Action.

Since the applied prior art, alone or in combination, fails to meet the limitations of claim 1, claim 1 is neither anticipated nor rendered obvious by the proposed combination of prior art.

As set forth with regard to claim 1, Nishio upon-individual-request transfer of a program does not suggest the proposed modification to the entire-system-proliferation approach of the AAA.

Claim 2 of the present invention emphasizes this difference by carrying forward the program transfer from a second, program-receiving node to a third, i.e., next, node. Putting aside the difference in signaling protocols between the AAA and Nishio on the one hand and the present invention on the other hand, such a sequence of program transfer could not occur in the Nishio video-on-demand system, except in a specific hypothetical situation. Such a situation would occur only if:

- a) bandwidth permits (col. 1, line 66);
- b) the second node, deciding it wanted a particular video, requested the video and was, of the nodes having the program, the node closest to the first node; and
- c) if the third node then, having decided it wanted the same video, made a request for that video and was, of the nodes having the program, the node closest to the second node.

The above-described, hypothetical situation points out the incongruity of attempting to combine Nishio and the AAA.

Claim 2 distinguishes patentably over the cited combination for at least the same reasons set forth above with regard to claim 1, and the individual, additional limitations of claim 2 serve to emphasize this difference over the cited combination.

Reconsideration and withdrawal of the rejection is respectfully requested.

As to claims 4 and 8, the Office Action likewise acknowledge that the AAA fails to disclose or suggest various limitations of those claims. Nishio fails to compensate for the shortcomings of AAA for the same respective reasons set forth above regarding claim 1. Reconsideration and withdrawal of the rejection is respectfully requested.

The other rejected claims each depend from one of the base claims and are deemed non-obvious for at least the same reasons as their respective base claims.

Thus, for example, claim 15, by reciting further steps in the iterative proliferation of program changes, further emphasizes differences between Nishio and the AAA and provides additional steps of an overall signaling protocol that can, at best, only be derived from the AAA and the art of record by impermissible hindsight. Support for the amendment of claim 15 is found in the specification (e.g., page 5, lines 6-10).

Claims 16 and 17 have been added to demonstrate the versatility of the present invention, and find support in the specification (e.g., portions of the text accompanying FIG. 3).

New claim 18 emphasizes that each node of the network receives the new program and receives it only once, unlike the AAA. Support for claim 18 is found in the specification (e.g., portions of the text accompanying FIG. 3).

New claim 19 emphasizes the two types of signals issued by the NMS of the present invention. Support for claim 19 is found in the original claim 1 and in the specification (e.g., page 11, lines 3-5 and other portions of the text accompanying FIG. 3).

New claims 20 and 21 find support in the specification (e.g., portions of the text accompanying FIG. 3).

New claim 22 finds support in original claim 4, and new claim 23 finds support in FIGs. 3 and 4.

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. The Examiner is invited to contact the undersigned in the event of any perceived outstanding issues so that passage of the case to issue can be effected without the need for a further Office Action.

Enclosed is a check for \$106.00 in payment of the fee for one independent claim in excess of three (\$88.00) plus one additional dependent claim (\$18.00) in excess of twenty claims total, for a total of \$106.00.

In the event that any additional fee is required to continue the prosecution of this Application as requested, please charge such fee to Deposit Account No. 502-470.

Respectfully submitted,

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